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OFFICE OF PETITIONS

In re Application of	:	
Shaffer et al.	:	
Application No. 10/699,534	:	ON PETITION
Filed: October 31, 2003	:	
Attorney Docket No. 25247B	:	

This is a decision on the petition under 37 CFR 1.137(a), filed April 24, 2006, to revive the above-identified application.

On November 7, 2005, the Office mailed a Notice of Allowance and Fee(s) Due, which indicated the due date for payment of the issue fee as February 7, 2006. In the absence of the timely payment of the issue fee, the application became abandoned on February 8, 2006. On April 24, 2006, petitioner filed the present petition, a completed Part B - Fee(s) Transmittal, and an authorization to charge the Deposit Account for the requisite fees. On April 6, 2006, the Office mailed a Notice of Abandonment.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to § 1.137(d).

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable."¹ Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).³ Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁴

¹ 35 U.S.C. § 133.

² In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

³ See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

⁴ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

In the present petition, petitioners asserted that they timely submitted the issue fee and publication fee by facsimile transmission on January 30, 2006, as evidenced by the enclosed copy of the first page of the Fax Transmittal. Petitioners stated that the docket clerk mistakenly transmitted the Issue Fee Transmittal to the previous USPTO facsimile number for acceptance of the issue fee payment, which had been coded into the facsimile machine for automatic transmittal. Petitioners explained that the docket clerk was not aware of the new USPTO facsimile number, and thus, it was not coded into the machine. Furthermore, petitioners asserted that it was assumed that the documents were successfully transmitted until the docket clerk checked the status of the application on PAIR.

A delay resulting from an error on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that:

- (1) the error was the cause of the delay at issue;
- (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance;
- (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.⁵

An adequate showing requires:

- (A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.
- (B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, file wrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.
- (C) Petitioners must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.

On October 18, 2005, the Office notified the public of the change in the facsimile number for payment of an issue fee and any required publication fee by authorization to charge a deposit account. See 1299 O.G. 98 (October 18, 2005). Specifically, the notice stated, in pertinent part:

Updated Lists of Exceptions: This notice replaces all prior Office notices specifying a fax number or hand carry address for certain patent related correspondence. Five significant updates have occurred to the lists of exceptions since they were last published on July 12, 2005. The five updated items are as follows:...

⁵ See MPEP 711.03(c)(III)(C)(2).

(3) the Office of Patent Publication facsimile number under List II, exception 2, has changed to 571-273-2885, and the local area telephone number to check on receipt of payments transmitted by facsimile under that exception has changed to 571-272-4200.

As previously stated, an application is "unavoidably" abandoned only where petitioners, or counsel for petitioners, take all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the USPTO. In this instance, petitioners have not shown that all necessary actions were taken to timely respond to the Notice of Allowance, and but for the intervention of unforeseen circumstances, the response was not timely received in the USPTO. Rather, it appears that such circumstances petitioners find themselves are the result of a foreseeable consequence due to lack of diligence.

First, petitioners did not indicate the person responsible for coding new facsimile numbers into the machine. Specifically, petitioners did not provide any explanation as to why the new facsimile number was not coded into the machine 3.5 months after the USPTO notified the public of the change. Additionally, petitioners did not submit any statement from the docket clerk setting forth the circumstances surrounding the delay as known to the clerk.

Second, petitioners failed to show that there was a business routine in place that could reasonably be relied upon to avoid errors in its performance. Petitioners did not provide an explanation of their procedures for responding to the USPTO via facsimile transmission and the existence of any checks to ensure the successful completion of the transaction. Additionally, petitioners did not explain their system for keeping all individuals at the firm abreast of changes in USPTO procedures, which will have a direct impact on the prosecution of the firm's applications. Moreover, petitioners did not discuss why the docket clerk, the attorney of record, or any other individual at the firm did not review the status of the transmission, which clearly indicated that 2 pages were not sent as a result of an "E-333)" error – "No answer." Additionally, petitioners did not explain why the status report indicating an error in the transmission did not cause any individual at the firm to investigate the matter. If petitioners had acted diligently, they would have determined an error had occurred and could have transmitted the documents again to the USPTO before the last day for payment of the issue fee.

Third, petitioners did not demonstrate that it was reasonable to rely on the docket clerk, especially in light of the fact that the clerk did not familiarize himself/herself of the changes in the procedures for communicating with the USPTO. Furthermore, petitioners did not supply information regarding the training, experience, or degree of supervision of the docket clerk to demonstrate that their reliance on the clerk represented the exercise of due care.

Accordingly, the petition under 37 CFR 1.137(a) is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

ALTERNATIVE VENUE

Instead of filing a renewed petition under 37 CFR 1.137(a), petitioner may wish to file a petition pursuant to 37 CFR 1.137(b) on the basis of **unintentional** delay.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed.
- (2) The petition fee as set forth in § 1.17(m), an additional \$1,500.00 for a large entity and \$750.00 for a small entity;
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and,
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant to § 1.137(d), unless previously filed.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.



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